

REMARKS

By this Amendment, Applicants have amended claims 15, 27, and 28.

Accordingly, claims 15-28 remain pending and under current examination. For the reasons presented herein, Applicants traverse the rejections set for in the Office Action¹, which:

- (a) rejected claim 27 under 35 U.S.C. § 101;
- (b) rejected claims 26 and 27 under 35 U.S.C. § 112, first paragraph;
- (c) rejected claims 15-20 and 25-28 under 35 U.S.C. § 102(b) as being anticipated by International Publication No. WO 02/35872 A1 ("Barberis"); and
- (d) objected to claims 21-24 as being dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim.

Regarding the 35 U.S.C. § 101 and § 112 Rejection of Claim 27

The Office Action rejected claim 27 under 35 U.S.C. § 101 as allegedly "not supported by either a process asserted utility or a well established utility." Office Action, p. 2. In response, Applicants have amended claim 27. Support for this amendment may be found in the Specification at, for example, p. 10, lines 1-3, which states that "[a]nother object of the present invention is a telecommunications network for radio apparatuses that is planned by means of the method of the present invention." As amended, claim 27 is thus fully "supported by a process asserted utility or a well established utility."

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

The Office Action further rejected claim 27 under 35 U.S.C. § 112, first paragraph, "since the claimed invention is not supported by either a process asserted utility or a well established utility . . . one skilled in the art clearly would not know how to use the claimed invention." Office Action, p. 2. According to the M.P.E.P., "[i]f a claim fails to meet the utility requirement of 35 U.S.C. 101 because it is shown to be nonuseful or inoperative, then it necessarily fails to meet the how-to-use aspect of the enablement requirement of 35 U.S.C. 112, first paragraph." M.P.E.P. § 2164.07(I)(A). In such a situation, "the burden shifts to the applicant to rebut the *prima facie* showing." M.P.E.P. § 2164.07(I)(C).

But, as shown above, claim 27 meets the utility requirement of 35 U.S.C. § 101. Claim 27 therefore not only shows utility (and rebuts the 35 U.S.C. § 101 rejection), but also clearly enables one of ordinary skill in the art to make and/or use the claimed invention (and consequently also rebuts the 35 U.S.C. § 112, first paragraph rejection). See M.P.E.P. § 2164.07(II). That is, as explained at, for example, p. 10, lines 1-3, the specification enables "[a] telecommunication network for radio apparatuses planned using the method as described in any one of claims 15-25" (emphasis added). Thus, while the utility is shown (35 U.S.C. § 101), the skilled artisan will also know how to effect the utility (35 U.S.C. § 112, first paragraph). Therefore, Applicants deem this rejection overcome, and respectfully request its withdrawal.

Regarding the 35 U.S.C. § 112, First Paragraph, Rejection of Claim 26

The Office Action rejected claim 26 under 35 U.S.C. § 112, first paragraph. See Office Action, pp. 2-3. Specifically, the Office Action alleged that "[c]laim 26 claims a system ... however, there is not enough description in the specification to enable a

person skilled in the art to develop the system ... without undue experimentation."

Office Action, p. 3. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 26 is a multiple dependent claim which depends from any one of claims 15-25. The Office Action did not reject any of method claims 15-25 under 35 U.S.C. § 112, first paragraph. Therefore, it appears that the Examiner's rejection is directed solely to the computing system for implementing the method. But, according to M.P.E.P. § 2161.01(III):

[w]hen basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. [§] 112, USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*.
(internal citations omitted, emphases in original).

The Office Action has not established a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the invention without undue experimentation. Instead, the Office Action merely made a blanket allegation that "there is not enough description in the specification to enable a person skilled in the art to develop the system of claim 26 without undue experimentation." Office Action, p. 3. In fact, the Office Action has not addressed any of the undue experimentation factors "to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is 'undue.'" M.P.E.P. § 2164.01(a), discussing eight factors enumerated in *In re Wands*, 858 F.2d

731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). According to M.P.E.P. § 2164.01(a), "[t]he examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole."

Moreover, regarding a computing system implementation as recited in claim 26, M.P.E.P. § 2161.01 states that:

[i]t should be recognized that sufficiency of disclosure issues in computer cases necessarily will require an inquiry into both the sufficiency of the disclosed hardware as well as the disclosed software due to the interrelationship and interdependence of computer hardware and software.

Claim 26 meets these requirements. In fact, the specification describes a particular workstation (the J6700 by Hewlett-Packard), with specific components and operating system, that can be used with the claimed invention. See Specification, p. 12, lines 9-12. Moreover, the disclosure provides flow charts (see Figs. 2 and 3) and equations (see, for example, p. 16 and p. 19) for implementing the claimed method. Thus, contrary to the allegations in the Office Action, the specification includes sufficient description to enable a person skilled in the art to make and/or use the claimed system. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Regarding the Examiner's Note on Claim 28

The Examiner noted that "[t]he term 'computer readable medium' as written in claim 28 is treated NOT to include any non-statutory term such as: signal, carrier wave, transmission, communication medium and the like." Office Action, p. 3. In response, Applicants note that they have amended claim 28.

Regarding the 35 U.S.C. § 102(b) Rejection of Claims 15-20 and 25-28

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-20 and 25-28 under 35 U.S.C. § 102(b) as being anticipated by Barberis. In order to establish anticipation under 35 U.S.C. § 102, the Examiner must show that each and every element as set forth in the claim is found, either expressly or inherently described, in Barberis. See M.P.E.P. § 2131.

Barberis, however, does not disclose each and every element of Applicants' claimed invention. Specifically, Barberis does not disclose at least Applicants' claimed "[a] method for planning a telecommunication network for radio apparatuses including a plurality of cells distributed over a geographical area by considering time-dependent characteristics of the network," and, "identifying a selection sequence in time of the pixels belonging to the service area pertaining to a pre-set cell according to a criterion for selection in succession, wherein the criterion for selection in succession is based on the values of a sorting function ($R_{m,n}$) which is a function of at least the quantity of traffic ($T_{m,n}$) pertaining to the pixel being examined," as recited in amended independent claim 15.

Instead, Barberis discloses identifying the pixels belonging to the service area on the basis of the depth calculated—in other words, those requiring the lowest transmitted power. See Barberis, p. 13, ll. 9-14. While this identification may relate to "iteratively adding the various pixel's traffic contributions to the loading factor until a predetermined limit . . . is reached" (Barberis, p. 12, ll. 23-26), Barberis does not disclose "[a] method for planning a telecommunication network for radio apparatuses including a plurality of cells distributed over a geographical area by considering time-dependent characteristics

of the network,” and, “identifying a selection sequence in time of the pixels belonging to the service area pertaining to a pre-set cell according to a criterion for selection in succession, wherein the criterion for selection in succession is based on the values of a sorting function ($R_{m,n}$) which is a function of at least the quantity of traffic ($T_{m,n}$) pertaining to the pixel being examined,” as recited in amended claim 15 (emphases added).

Since Barberis fails to disclose each and every element of Applicants' claim 15, Barberis does not anticipate Applicants' independent claim 15. Independent claim 15 should therefore be allowable. Claims 16-28 depend from independent claim 15 and should also be allowable at least by virtue of their dependence from base claim 15. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 15-28.

Regarding the Objection to Claims 21-24

Applicants acknowledge with appreciation the Examiner's indication that claims 21-24 are drawn to allowable subject matter. For the reasons discussed in this paper, however, claims 21-24 should be allowable due to their dependence from allowable claim 15. Applicants therefore respectfully decline to amend the corresponding base claim to include the recitations of one or more of claims 21-24.

Conclusion

Applicants request reconsideration of the application and withdrawal of the objections and claim rejections. Pending claims 15-28 are in condition for allowance, and Applicants request a favorable action.

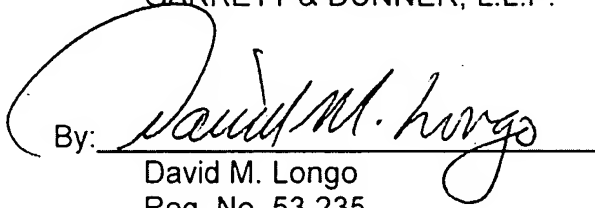
If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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